



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/864,525	05/23/2001	Tadashi Goino	2842.04US01	3075

7590 08/24/2006

Douglas J. Christensen, Esq.
Patterson, Thunte, Skaar & Christensen, P.A.
4800 IDS Center
80 South Eighth Street
Minneapolis, MN 55402-2100

EXAMINER

ZURITA, JAMES H

ART UNIT PAPER NUMBER

3625

DATE MAILED: 08/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/864,525

Applicant(s)

GOINO, TADASHI

Examiner

James H. Zurita

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,8 and 9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,8 and 9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Prosecution History

On 23 May 2001, applicant filed the instant application. Applicant claims priority to the following applications, filed in Japan

- 2000-356812, filed on 11/22/2000, 275 pages
- 2000-302727, filed on 10/02/2000, 106 pages
- 2000-193457, filed on 06/27/2000, 48 pages

On 27 December 2001, the application was published as PG-PUB 20010056396.

On 4 May 2006, the Examiner issued a restriction requirement.

On 5 June 2006, applicant responded to the requirement.

Election/Restrictions

Applicant's election without traverse of claims 1, 2, 8 and 9 in the reply filed on 5 June 2006 is acknowledged.

Applicant cancelled claims 3, 17-42, 44-50, 52-92, 98-102, 117 and 118.

Claims 4-7, 10-16, 43, 51, 93-97, 103-116 and 119-121 are withdrawn as being directed to a non-elected invention.

Claims 1, 2, 8 and 9 will be examined.

Information Disclosure Statement

The information disclosure statements fail to comply with 37 CFR 1.98(a)(3) because they do not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language.

Art Unit: 3625

Applicant has filed 4 Information Disclosure Statements. Each has problems:

IDS	IDS Section & problem	Examiner Notes
23 May 2001	<u>Foreign Patents</u> Missing English abstract 10-078922 11-328271	10-078922 appears in the IDS of 11 March 2003
3 June 2002	<u>US Patent Published Documents</u> Unable to locate 0042041 0049658	Examiner searched for these, but was not able to find documents with the listed inventor and document number
11 March 2003	<u>Foreign Patents</u> [1] JP2001129787 corrected to JP200112978 [2] JP11504455 is WO 96/34357, published October 31, 1996	<u>Other Documents</u> Need translation for each of three on the list
18 May 2006	<u>Foreign Patents</u> JP 64-62799 has only an English language claim, no English Abstract	JP 2003-032922, 3 pages, was submitted on this date, but does not appear in the IDS list.

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Objections

Claim 2 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

In claim 2, “***...attribute information...***”, some attributes are convertible into one of various prices, as in paragraphs 0711 and 0712, contradicting the limitation of claim 1 that an element is “...other than...price...”

In claims 8 and 9, “**...trade conditions...**”, some conditions are convertible into one of various prices, as in paragraphs 0711 and 0712, contradicting the limitation of claim 1 that an element is “...other than...price...”

In claim 2, the phrase “...an article or a service to be traded...” appears to refer to claim 1’s “...an article or a service to be traded...” Claim 2 should be amended to read “...**the** article or a service to be traded...” to refer back to claim 1.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

In claim 1, the preamble is incomprehensible. See emphasized text:

Claim 1. A method of conducting an auction for bidding **off [???**
[an article or a service], or a person [??? **who receives provision of [an article or a**
service],
through a network, said method comprising...

While it is clear that one can auction articles and services, it is not clear what applicant means by “...**bidding off...**” Similarly, it is not possible to determine whether applicant is also auctioning a person as well from the phrase “...**or a person who receives provision of [something]...**”

In claim 1, the limitation “...**other than ... price...**” is indefinite and it is not possible to determine the metes and bounds of the claims. The phrase “...other than ...

Art Unit: 3625

price...” appears in the second embodiment (Figs. 15-23) and in the seventh embodiment (Figs. 1-3, 15, 16, 18, 49-69). The specifications refer to multiple prices. The claims do not identify which price is being addressed. The limitation is mentioned in Paragraphs 150, 162, 554, 611, 684 and 687. The disclosures also refer to other prices, for example: cost, discounted price, desired price, fixed price, mere price, lowest price, sales price, slide price, standard price, unit price, minimum price, purchase price, step-wise price, offered price, fee [paragraph 0225], rating system (price) [paragraph 0251], market price (value) [paragraph 0695]. See also references to payment, which appears to require knowing a price [or amount] to pay.

For purposes of Examination, the limitation will be interpreted to read on auctions that have multiple parameters and are not based solely on price.

Claim 1 refers to “..an article or a service **to be traded...**” and to “...an **object to be bidden...**” It is not clear what the difference is, and whether applicant relies on the terms for patentable distinction.

In claims 1 and 8, the alternative language assures that information will always be something other than price:

Collection procedure [claim 1]

[a] an element **other than a price** or [b] converted information converted to said element will

bid procedure [claim 1]

[said element or said converted information offered

bid acceptance procedure: [claim 1 and 8]

[a] said element included in said bid information or [b] an element derived by converting said converted information],

In claim 1's collection procedure, the highlighted language is unclear:

... server provides information serving as a **reference for** bidding [...for?...] an article or a service **to be traded [...?...]**, and [server] transmits collection information **to collect**

Art Unit: 3625

bids requesting to offer [a] an element other than a price or [b] converted information converted to said element...

The limitation will be interpreted as presenting information via an interface to a potential bidder.

In claim 2, the phrase “[...request procedure...] ***prior*** to said collection procedure ***or between*** said bid procedure and said bid acceptance procedure...” renders the claim indefinite. It is possible to have multiple interpretations of claims 2, 8 and 9. For example:

Flow A	Flow B
Request procedure (claim 2)	Collection procedure (claim 1)
Collection procedure (claim 1)	Bid procedure (claim 1)
Bid procedure (claim 1)	Request procedure (claim 2)
Bid acceptance procedure (claim 1)	Bid acceptance procedure (claim 1)

In claims 1 and 2, the term “***...or...***” renders the claims indefinite, since it is not possible to determine the scope of the claim as requiring both items or only one of the items separated by the ***or***. For purposes of this examination, examiner will give the term its broadest reasonable interpretation and consider that the particular condition is satisfied if one of the limitations is met.

In claim 2, “***...attribute information...***” is indefinite, since it is not possible to determine what is or not attribute information (as in paragraphs 0472, 0711 and 0712) and how such information is different from element information. At times it appears that attributes and elements are interchangeable and it is not possible to determine the scope of the claims. Some attributes are convertible into one of various prices, as in paragraphs 0711 and 0712, contradicting the limitation of claim 1 that an element is “...other than...price...”

Art Unit: 3625

[0711] The **attribute** can help differentiate from other articles and services. The **attribute** includes, for example, design, contents of service, specification, model number, performance, effect, quality, material, strength, reliability, taste, smell, fragrance, color, brightness, illuminance, sound volume, sound quality, temperature, pressure, size, component, log, career, title, capability, speed, length, weight, volume, bulk, area, nature, point, shape, pattern, coloring, type, system, product name, article name, and so on. However, these are mere examples. While some of these **attributes can be converted to a price** depending on articles and services, **the unit of a unit price of an applied article does not fall under the attribute**. For example, the unit of the unit price of an article sold in quantitative units does not fall under the **attribute**. However, when a wire of a standard length is cut into 2-meter pieces for sales, this "2 m" is nothing but a choice of a buyer and does not at all characterize the wire itself, so that it does not fall under the **attribute** of the wire. However, with a wire of a length out of standard, for example, 1000 km, this "1000 km" sufficiently characterizes the wire, so that it falls under the **attribute**. Whether a numerical value is an **attribute** or not is determined from determination as to whether or not an associated article is characterized by the numerical value, i.e., a numerical value represented by an element (unit or the like) is not a standardized value, the article can be made, owned, or skilled only by a particular enterprise or craftsman, and so on. **It should be noted that attribute information on an article or a service offered by a client in the request procedure is not an element, so that the price may be of course included [emphasis added]**

In claims 2, 8 and 9, it is not possible to determine what actor is providing the information at the client, a potential buyer or potential seller. This renders that claims indefinite, since desired trade conditions appear to totally exclude price considerations.

In claims 8 and 9, the term **"...trade conditions..."** is indefinite. The term appears to refer to trading due date condition (Abstract), trade period conditions [paragraph 0120], favorable conditions for the client [paragraph 0126], trading conditions on time slide scheme and price slide setting type [paragraph 0131], trading conditions such as bid information, bidder offer conditions [paragraph 0135], bidder offered conditions (**price**, article delivery date and so on) of [paragraph 0151]. Several of these items overlap and contradict what applicant refers to as **attributes** and **elements**.

In claims 1, 2, 8 and 9, it is not possible to determine the scope of several terms in the claims, since the specifications appear to describe the terms as overlapping in scope and contradicting each other's requirements:

- elements (claims 1 and 8) can be price and non-price elements
- attributes (claim 2) can be price and non-price attributes
- trade conditions (claims 8 and 9) can be price and non-price conditions

In claims 1, 2, 8 and 9, it is not possible to reliably define the terms element, attribute and trade conditions and their equivalents in order to avoid infringement. The Examiner notes that the various labels (*element*, *attribute*, *trade condition*) do not appear to provide patentable distinction and are given little or no patentable weight.

Specification

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

The specification appears to be a literal translation into English from a foreign document and is replete with idiomatic errors.

In paragraphs that contain the claimed limitation “***...other than...price...***” it is not possible to determine a meaning for equivalents to avoid infringement. For example:

[0687] In the respective [second] embodiment described above, an element other than the price may be limited not to mean to include a bid conducted with the element in the form of a mere conversion of a price, and substantially in the form of a mere price bid. For example, in the position auction, the element other than the price does not include those which are mere conversion from the price, and with which a bid is conducted with the price. For example, the element other than the price does not include those used in a

Art Unit: 3625

bid in the form of a mere alternative of the price, such as a bid conducted with an element having a proportional relationship with the price. However, an auction method which has a meaning of using an element other than the price is included, such as that which cannot be said to be a mere alternative of the price, and produces inherent effects other than the price eventually by conducting a bid with the element other than the price. For example, a higher rate is burdened in accordance with a distance over which a taxi goes to receive a customer, it is out of the question to conclude that such a method is not included in the invention, ignoring the effect of reducing a waiting time of the customer on the basis of such a reason that bidding of the nearest taxi leads to a lower rate, and so on. With the employment of such a method, it is possible to more satisfy requirements other than the price.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1, 2, 8 and 9 are rejected under 35 U.S.C. 102(e) as being anticipated by Wellman (US 6,952,682).

As noted above, it is not possible to determine the scope of several terms in the claims, since the specifications appear to describe the terms as overlapping in scope and contradicting each other's requirements:

Art Unit: 3625

- elements (claims 1 and 8) can be price and non-price elements
- attributes (claim 2) can be price and non-price attributes
- trade conditions (claims 8 and 9) can be price and non-price conditions

Prior art will be interpreted to read on applicant's elements, attributes and trade conditions where prior art discloses any non-price dimension/characteristic/basis for evaluation.

As per claim 1 (as interpreted), Wellman discloses a method of conducting an auction over a network with client-server topography (see, for example, Fig. 2 and related text), the method comprising:

a collection procedure in which the server

provides information [concerning an item to be auctioned], as in Fig. 2 and related text;

transmits requests for bids for the item [request includes fields for non-price elements] (see input screen 200, which is transmitted from server 110 to various clients 102 and 104; see also Col. 2, lines 25-29, where price is expressed in terms of a uniform measurement unit) ;

a bid procedure in which the server

receives, from bidders, bid information including the non-price element (see, for example, Fig. 2, an input screen that includes non-price element (i.e., applicant's "element other than a price or converted information converted to said element"; see also Fig. 5A, item 502, "collect offers from buyers and sellers");

a bid acceptance procedure in which the server

executes bid processing for finding a result of bidding with the non-price element (see, for example, at least Fig. 7 and related text);

selects a successful bidder (see, for example, at least Fig. 7, step 710 and related text).

As per claim 2 (as interpreted), Wellman discloses that the server prompts the client to enter attribute information required to identify an item to be traded (see, for example, Fig. 3, attributes, nominal values, variance), and receives request information including the attribute information See, for example, at least Col. 5, lines 42-49, where the information input at a client is received at the server.

As per claim 8 (as interpreted), Wellman discloses that the server prompts the client to offer desired trade conditions (see, for example, references to desired delivery time, as in Col. 5, lines 33-40)

receives the request information including the desired trade conditions (the information is sent from the client to the server, and is used by the server in determining matches, screens 200 and 300);

transmits the desired trade condition as information used as a reference in conducting a bid to the terminal of a bidder to present the desired trade conditions to the bidder (see at least Fig. 8 and related text, for example); and

executes the bid processing with the non-price element in accordance with the desired trade conditions based on the bid information (see Fig. 7 and related text).

As per claim 9 (as interpreted), Wellman discloses that the server prompts an offer of the desired trade conditions on the request screen (see, for example, references to desired delivery time, as in Col. 5, lines 33-40); and

presents the desired trade conditions on the bid screen (see, for example, at least Fig. 8 and 9 and related text).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James H. Zurita whose telephone number is 571-272-6766. The examiner can normally be reached on 8a-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

James Zurita
Primary Examiner
Art Unit 3625
16 August 2006

James Zurita
Primary Examiner